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Customized PTO/SB/21 (04-04)

TRANSMITTAL FORM (for all correspondence after initial filing)	Application #	09/787,195
	Confirmation #	6088
	Filing Date	April 17, 2001
	First Inventor	DAMES
	Art Unit	1743
	Examiner	Quan, Elizabeth S.
Total number of pages in this submission =	Docket #	P07109US00/BAS


ENCLOSURES (check all that apply)	
<input type="checkbox"/> Fees calculated below	<input type="checkbox"/> Response to Missing Parts/Incomplete Appl.
<input checked="" type="checkbox"/> Response	<input type="checkbox"/> Certified Copy of Priority Document(s)
<input checked="" type="checkbox"/> including Attachment (Annex B)	<input type="checkbox"/> Information Disclosure Statement
<input type="checkbox"/> After Final Amendment/Reply	<input type="checkbox"/> Drawing(s)
<input type="checkbox"/> including Attachment(s)	<input type="checkbox"/> Terminal Disclaimer
<input type="checkbox"/> Extension of Time Petition	<input type="checkbox"/>
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FEES CALCULATION: For claims if required and/or other fees as shown below:					
	NOW	Previously Paid For	Present Extra	Rate	\$
<input type="checkbox"/> TOTAL CLAIMS	21	21		X \$ 18 =	
<input type="checkbox"/> INDEP. CLAIMS	1	1		X \$ 86 =	
TOTAL OF ABOVE CLAIMS FEES =					
<input type="checkbox"/> Reduction by 1/2 for small entity status of applicant					
SUBTOTAL =					
<input type="checkbox"/> Fee for extension of time (per attached Petition)					
<input type="checkbox"/> Other fee for					
TOTAL OF ALL FEES =					0

☒ If no payment or an insufficient payment is enclosed and a fee is due in connection herewith, the Commissioner is authorized to charge any fee or additional fee due in connection herewith to Deposit Account No. 12-0555.

☒ In the event that a petition for extension of time is required to be submitted herewith and that a separate petition is not submitted herewith, applicant hereby petitions under 37 CFR 1.136(a) for an extension of time of as many months as are required to render this submission timely. Any fee is authorized above.

Date: May 26, 2004


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RESPONSE

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Commissioner for Patents
P.O. Box 1450
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S I R:

In the Restriction Requirement dated April 26, 2004, the Examiner further restricted the pending claims to one of three groups asserting that there is lack of unity among the claims alleging that the solid support of claim 1 does not make a contribution over the prior art such that unity is lacking and restriction is appropriate between the device of claims 1-10 (identified as Group I) and the method of making of claims 11-16 (identified as Group II).

The Examiner has raised a lack of unity of invention argument based on an alleged obviousness of claim 1. It appears the Examiner has inappropriately raised on obviousness-type rejection of claim 1, including citing prior art, before an actual substantive examination of the present application. The Examiner's foundation for the lack of unity misapplies the requirements of PCT Rule 13.2.

PCT Rule 13.2 states that the requirement of unity of invention shall be fulfilled when there is a technical relationship among a group of inventions involving one or more of the same or corresponding special technical features. "Special technical features" are defined as being those technical features which define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. Article 27(1) prohibits elected offices from applying requirements as to the form or

content of the application which differ from those under the PCT. Hence PCT Rule 13 is the only standard which may be applied to determine unity of the present application.

Annex B of the Administrative Instructions under the PCT (copy of relevant pages attached) provide the basis on which determinations of unity should be made. The claims for which the restriction requirement is traversed come under the heading of "Combinations of Different Categories of Claims" in Part 1(e). In Part 1(e)(i) it is explicitly stated that Rule 13 should be construed as permitting the inclusion of the combination of "an independent claim for a given product, [and] an independent claim for a process specially adapted for the manufacture of the said product".

Part 1(e) goes on to state that "a process is specially adapted for the manufacture of a product if it inherently results in the product with the technical relationship being present between the claimed product and the claimed process.

Further, U.S. rules implementing PCT Rule 13.2 state that a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to a product and a process specially adapted for manufacturing of the said product (37 C.F.R. § 1.475(b)(3)).

In the present case claim 11 is clearly a claim to a process specially adapted for the manufacture of the product of claim 1, as is evident from the fact that the claim is to "a method of fabricating the supports of claim 1". A technical relationship exists between the product of claim 1 and the process of claim 11 at least in the feature of anodising.

Therefore the process of claim 11 inherently results in the product of claim 1 with a technical relationship being present between the claimed product and the claimed

process, in accordance with Part 1(e) of Annex B, Part 1(d), second paragraph of Annex B makes it clear that these principles are “interpretations of and not exceptions to the requirements of Rule 13.2”.

Thus, insofar as it can be understood, the Examiner’s final assertion (last two lines of section 2) that the invention of Group I (i.e., claims 1-10) is totally different to that of Group II (i.e., claims 11-16) because it would be classified in a different area has no basis in PCT Rule 13 or 37 C.F.R. § 1.475 and is thus irrelevant to the question of unity. Should the Examiner believe claim 1 is obvious, the appropriate response is to raise an obviousness rejection is during substantive examination.

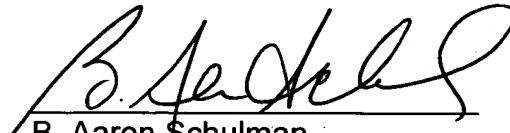
Furthermore, it is noted that neither the International Searching Authority (ISA) nor the International Preliminary Examination Authority (IPEA) found a lack of unity between the claims of the application relating to the support and the claims relating to the method of fabricating the support. This conclusion was despite the ISA citing documents in the “X” category against the claims to the support as originally filed.

Finally, notwithstanding the arguments above with regard to the inappropriateness of raising an obviousness-type rejection at this stage in prosecution, for the avoidance of doubt, it is respectfully submitted that the Applicants maintain that the Examiner’s conclusion with regard to the obviousness of claim 1 is incorrect. However, it does not appear either necessary or appropriate to argue against this conclusion at this stage in the prosecution of the present application. This consideration is particularly relevant given that the Examiner has given a deadline of only one month for consideration of a newly cited prior art document.

To complete the response, Applicants without prejudice to the above-stated arguments, elect Group I (claims 1-10) with traverse.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "B. Aaron Schulman", written over a horizontal line.

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